

Claim 56 (new): A method for returning to a sender mail for a recipient, as set forth in claim 46, wherein the mail includes an envelope and said step of adding to said mail access information includes the step of placing an advertisement for a locator service upon said envelope.

REMARKS

Examiner provides no explanation of U.S.C. §102 rejection other than listing prior art references for each step of a claim. Applicant kindly asks Examiner to provide rationale, comment, context, or explanation of how such selected references teach such steps so that the Applicant does not have to speculate or guess Examiner's reasoning. Applicant is not a mind reader.

I. Rejection of Claim 21 Under 35 U.S.C. §101

In Paragraph 2 of the Office Action, the Examiner has rejected claim 21 under 35 USC 101 "because the claimed invention is directed to non-statutory subject matter." The Examiner does not describe how the claimed invention fails to meet the two conditions set forth in Paragraph 2 of the Office Action, so the basis for this rejection is unclear to Applicant. Nonetheless, Applicant presents herewith two new independent claims 41 and 46, both of which present an invention within the technological arts that produce a "useful, concrete and tangible result." For example, claim 41 presents a mail piece with three markings. One marking assists the sender in locating current contact information for the recipient. Claim 46 sets forth a method including a step for adding such useful information to undeliverable postal mail.

II. Rejection of Claims 21-29 Under 35 U.S.C. §102(e) as being unpatentable over Uhl

Claims 21-29 stand rejected under 35 U.S.C. §102(e) as being unpatentable by Uhl (U.S. Patent 6,292,709). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Applicant agrees with Examiner that Uhl reads on the first two steps of independent Claim 21. Applicant also agrees with Examiner that Uhl teaches providing information relating to the article of mail. However this is where the similarities between Applicant and Uhl end.

Uhl teaches generating information that assists the postal carrier only. However Applicant in no way teaches generating information that assists the postal carrier.

Applicant teaches generating information that assists the sender only. However Uhl in no way teaches generating information that assists the sender.

Unlike Uhl, Applicant does not teach assisting the postal carrier in any way but rather Applicant teaches generating information that can benefit the sender instead.

Uhl teaches improvements to the mail forwarding process whereas Applicant does not teach improvements to mail forwarding in any way but rather teaches how assistance can be provided to a sender after all mail forwarding techniques have been exhausted. Bottom line is that Uhl does not in any way teach returning mail to a sender that includes additional information for the purpose of helping sender attempt to locate a recipient.

Examiner references (Uhl Claims 1, 4, and 9; col. 4, lines 33-61, and abstract) teach how to manage mail that can be forwarded. *None of these references teach steps for assisting the sender after mail is returned to sender.*

Dependent Claims

Examiner also makes reference to Uhl Figs. 7-12 and associated spec col. 7, line 38 – col. 9, line 65 regarding dependent claims. Fig. 7 and corresponding specification relates only to forwarding mail which is not taught or claimed by Applicant. Though Figs. 8 and 9 relates to returned mail, corresponding specification (Uhl col. 9, lines 1-3) states it best which is that such information assists a delivery person with successfully returning the mail and does not assist the sender in any way. Figs. 11 and 12 also relate to returned mail but again does not in any way teach or suggest how such process can assist the sender after mail has been returned.

Claim 25

Examiner references Uhl Fig. 10 which depicts a marking that may be interpreted as a form of advertisement. However, in no way does this depiction teach how such advertisement can assist the sender in locating the recipient after mail has been returned to sender. For example, knowledge of “City of Sender” in no way assists the sender with attempting to locate the recipient.

New Claims 41-56

Claims 41-56 overcome Uhl under the same rationale as written above regarding Claims 21-29. No where does Uhl teach *“including access information to assist the sender in locating current contact information for the recipient.”*